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CESARI AND MCKENNA, LLP			PLUCINSKI, JAMISUE A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/966,033	Applicant(s) SMITH ET AL.
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

1) Responsive to communication(s) filed on 02 February 2010.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2-4,7-11,13,20-26,28-30,32 and 34-48 is/are pending in the application.
 4a) Of the above claim(s) 3,7-11,13,20,25,26,32 and 34-47 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 2,4,21-24 and 28-30 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 4, 21-24, and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claim 2: the phrase "associating linked information with respective user identifiers" is indefinite. A claim must be whole in and of itself. Therefore if the user identifier was used, it must first be collected. It is unclear where the user identifiers came from, and how they are related to the linked information to become "respective". Are the user identifiers part of the information that is collected with the linked information? Is that how the information becomes linked is by linking the information to the user identifiers? Or does the information that is collected somehow match with other information that is associated with the user identifiers? Therefore it is unclear what "respective user identifiers" is referring to.

4. Claim 2 recites the limitation "the user" in line 10. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 2 recites the limitation "the senders" in line 12. There is insufficient antecedent basis for this limitation in the claim.

6. With respect to Claim 2: the phrase "linking to delivery status information an attachment..." is indefinite. The delivery status information collected is one in the linked information; however the linked information is part of a Markush grouping in the acquiring step.

It is unclear if this is a different "status information", or if this is an optional step that is only done when the linked information is the delivery status information. For example, if the information acquired was the digital copy of the mail piece, then status information is never collected. Therefore it is unclear how the messages can be attached to something that was never collected.

7. With respect to Claim 2: the phrase "providing said linked information for the mail pieces..." is indefinite. It is unclear to the examiner who or where this information is provided to.

8. Claim 4 recites the limitation "the contents" in line 8. There is insufficient antecedent basis for this limitation in the claim.

9. With respect to Claim 4: the phrase "linking the mail piece delivery status information with respective user identifiers" is indefinite. A claim must be whole in and of itself. Therefore if the user identifier was used, it must first be collected. It is unclear where the user identifiers came from, and how they are related to the linked information to become "respective". Are the user identifiers part of the information that is collected with the linked information? Is that how the information becomes linked is by linking the information to the user identifiers? Or does the information that is collected somehow match with other information that is associated with the user identifiers? Therefore it is unclear what "respective user identifiers" is referring to.

10. With respect to Claim 21: the phrase "creating linked information for each mail piece containing mail piece information providing the user with the capability to track and trace mail pieces sent to or from one or more addresses" is indefinite. This limitation appears to be one long run on sentence, therefore causing it to be unclear what is actually being claimed. Does the

linked information contain mail piece information, or is linked information only created for mail pieces which contain mail piece information? Is there an actual positive step of providing the user with the capability to track and trace, or is this a result of creating linked information?

11. With respect to Claim 21: the phrase “receiving linked information from one or more mail piece delivery companies...” is indefinite. In Step C of the claim, linked information is already created by the computer program, therefore it is unclear if this is an update of the linked information or if this is additional linked information.

12. With respect to Claim 21: the phrase “...relating to those respective mail pieces that are assigned to the respective user identifiers that are associated with the users to which the user identifiers are associated” is indefinite. The claims have not previously assigned any items to user identifiers, therefore causing the claim limitation to be unclear.

13. Claim 21 recites the limitation “the contents” in line 15. There is insufficient antecedent basis for this limitation in the claim.

14. With respect to Claim 21: the phrase “displaying said linked information on a user’s personal web page consisting of the information concerning the contents of the respective mail pieces” is indefinite. The linked information already contains more information than the contents of the mail pieces, therefore it is unclear how the personal webpage can consist of only the contents of the mail pieces.

15. With respect to Claim 22: the phrase “associating with the respective users identifiers respective mail pieces directed to or sent by the respective users and informing the use or an incoming mail piece” is indefinite. First it should be noted that the word “users” appears to be grammatically incorrect and should either “user” or “user’s”. Second, the claim limitation states

that the mail pieces can be "directed to or sent by" the user, therefore if the mail piece is sent by the user, then you could not inform the user of an incoming mail piece, because it would be outgoing not incoming.

16. Claim 22 recites the limitation "the contents" in line 14. There is insufficient antecedent basis for this limitation in the claim.

17. With respect to Claim 22: the phrase "receiving mail piece delivery status information... displaying said information on a user's personal web site and linking the mail piece delivery stats information relating to the respective mail pieces to the respective user identifiers..." is indefinite. The examiner is unclear why and how the information is displayed on the web page first, prior to linking the information. Doesn't the information have to be linked to the respective user before it is displayed on the personal web page of the user?

18. Claim 22 recites the limitation "the respective senders" in line 15. There is insufficient antecedent basis for this limitation in the claim.

19. With respect to Claim 22: the phrase "receiving images of at least a portion of the contents... displaying said images on a user's personal web site and linking to the delivery stats information an attachment consisting of the images of at least a portion of the contents of the respective mail pieces" is indefinite. The examiner is unclear why and how the images are displayed on the web page first, prior to linking the attachment with the status information. Don't the images have to be linked to the respective user before it is displayed on the personal web page of the user?

20. With respect to Claim 23: the phrase "providing a graphical user interface connected to" is indefinite. It is unclear to the examiner if the interface is connected to something, or it is connected in order to perform some function.

21. With respect to Claim 23: the phrase "provide links for the user to respective mail pieces delivery companies and respective sellers of said mail pieces allowing the user to perform at least one of: sending or receiving a message, receiving or paying a bill and verifying information based upon a digital signature" is indefinite. The claim limitation appears to be one long fun on sentence, and therefore causing the claim to be unclear. The examiner suggests adding commas into the claim to more clearly define the links and who they are providing the links to. Currently the claim read that the links are provided for the user to perform a function, therefore causing it to be unclear what function that is. The examiner suggests adding a comma before and after "for the user".

22. With respect to Claim 28: the phrase "associating said linked information about the mail piece with respective user identifiers" is indefinite. A claim must be whole in and of itself. Therefore if the user identifier was used, it must first be collected. It is unclear where the user identifiers came from, and how they are related to the linked information to become "respective". Are the user identifiers part of the information that is collected with the linked information? Is that how the information becomes linked is by linking the information to the user identifiers? Or does the information that is collected somehow match with other information that is associated with the user identifiers? Therefore it is unclear what "respective user identifiers" is referring to.

23. Claim 28 recites the limitation "the senders" in line 11. There is insufficient antecedent basis for this limitation in the claim.

24. Claim 34 recites the limitation "the contents" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

Claim Rejections - 35 USC § 101

25. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

26. Claims 21-24 and 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

27. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "useful, concrete and tangible result." The test for practical application as applied by the examiner involves the determination of the following factors:

(a) "Useful" - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. If the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" - Applying *In re Warmerdan*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

28. In Claims 21-24 and 28-30 the claims are directed towards a computer readable medium as well as a computer readable memory. The Specification of the specification is silent as to the definition of the word memory as well as silent as to the use of the word medium. A medium and memory can be in two different forms, a transitory form such as a signal as well as a non-transitory, tangible form such as hardware or a physical medium. In order for a claim to meet the statutory requirements of 35 USC 101, the claim must be tangible, and therefore may not contain

the possibility of being a signal or a transitory medium. The specification is silent as to what constitutes the medium and the memory, therefore the applicant must specify in the claim that the medium or the memory is non-transitory in order for the claim to be statutory. The examiner suggests the wording “non-transitory”.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 2, 4, 21-24 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilibin et al. (US 2005/0197892) in view of Guidice et al. (6,463,420) and Kanevsky et al. (6,285,777).

31. With respect to Claims 2, 4, 20-323 and 28-30: Bilibin discloses the use of a method comprising the steps:

- a. Associating respective users with user identifiers (Paragraph 162, registering and creating user ID and passwords);
- b. Receiving information which includes status information from one or more mail resources (See Figure 64b-1 with corresponding detailed description), and from the information received, creating linked information for each mail piece (Bilibin discloses the user entering in the package number when tracking, the system then retrieves

information from various carriers, which includes status information, links the information to the user and then displays it on the website, See Figures 68 and 70-71 with corresponding detailed description, the examiner considers this to be creating linked information).

c. Associating with the respective users mail pieces directed by others, different carriers, to respective users sent to others by the respective users (Figures 56 and 57 with corresponding detailed description, the examiner notes who the mail piece is sent to does not patentably distinguish itself from the prior art, the tracking would be processed the same regardless of the recipient, therefore considered to be non-functional descriptive material);

d. Linking to the user identifiers to which the mail pieces are associated mail piece delivery status information relating to the respective mail pieces (Figure 50, Reference numerals 441-442 with corresponding detailed description);

e. Receiving information concerning the contents of the respective mail pieces from the senders of the respective mail pieces and linking to the delivery status information an attachment consisting of the information concerning the contents of the respective mail pieces (Figures 51-54 with corresponding detailed description). However, the specific type of information (i.e. text information, graphics audio file) is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The providing and display steps would be performed the same regardless of the noises or pictures presented. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381,

1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

- f. Receiving one or more messages from the senders of the mail pieces and attaching the messages to the linked information (See Figure 51 with corresponding detailed description)
- g. Providing a graphical interface configured for entering user identifiers and providing access (Paragraph 147 and Figure 54 Reference numeral 1258 with corresponding detailed description);
- h. Producing on the users personal webpage a respective listing of the delivery status information directed to the respective users (See Figure 76, Bilibin discloses a shipping log of inbound and outbound packages for the user, therefore the examiner considers this a users personal webpage);
- i. Provide the mail piece delivery status information that is linked to the user identifiers that are associated with the respective users, and
- j. Provide to the respective users the associated information concerning the contents of the respective mail pieces (See Figures 71-72 with corresponding detailed description)
- k. Including links to the respective messages in the listing of the delivery status information, which allows a user to perform sending and receiving a message (Figure 72 with corresponding detailed description, which allows a user to receive a message when delivered).
- l. Bilibin discloses that everything that is done, is done through a webpage, where a user signs in and can view transaction history as well as shipping logs, the examiner

considers this to be a personal webpage, due to the fact that a user has to sign in to access all their information, which is stored in the server (See Figure 76 with corresponding detailed description).

32. Bilibin discloses linking the user identifiers to the mail pieces, however fails to teach linking the mail piece delivery status with the user identifier. Guidice teaches the system identifying if the submitted orders that can be tracked according to the user ID (Column 6, lines 45-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to combine the associated steps of Guidice with the multi-carrier tracking of Bilibin. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

33. Bilibin also fails to teach the user accessing the above information by entering user identifiers. Guidice teaches the user entering the ID and password in order to be able to select the order for which the user wishes to track (Column 6, line 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the accessing steps of Guidice with the multi-carrier tracking of Bilibin. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable (See KSR [127 S Ct. at 1739] "The

combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

34. Bilibin and Guidice discloses the use of tracking information according to users, however fails to teach acquiring information from one or more mail piece sources, postal services or delivery companies and creating a digital shadow for each mail piece and linking the shadow to the user identifier. Knevsky discloses the use of internet assisted mail piece tracking, where a paper mail is received at the post office. The post office scans the paper mail, then forwards the scanned information data to the user/e-mail address or to the local post office (See abstract). The examiner considers this to be a digital shadow of the mail piece, which is associated with the user, address or e-mail address and the users mail database (See Figure 2 with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Bilibin and Guidice to include the digital shadowing of Knevsky in order to allow the user to choose how they want to receive mail and for speeding up surface mail (See Knevsky, Columns 1 and 2).

35. With respect to Claims 24: Bilibin discloses the use of one or more messages being provided by the sender associated with the mail piece (See Figure 51 with corresponding detailed description)

36. With respect to claim 48: Bilibin discloses the use of a mail piece tracking and tracing system comprising:

m. One or more servers associated with multiple package delivery systems coupled to a network and interfacing with users and storing user identifiers (See Figure 5 with corresponding detailed description);

n. A plurality of noted connected to the network running software executables with web browsers where users can access the system and track and trace mail pieces (See Figures 2, 5 and 68 with corresponding detailed descriptions).

Response to Arguments

37. Applicant's arguments filed 2/2/10 have been fully considered but they are not persuasive.

38. With respect to Applicant's argument that Bilibin does not receive the information from a plurality of sources then creates the linked information: Bilibin discloses receiving information from a plurality of carriers, then links in the information and saves it in the system. The request for information is initiated by the user, however no where in the claims does it state that the receiving of information is not done in response to a request for the information. By saving the information in the database, that is essentially creating the linked information. When a first package tracking number is entered into Bilibin to track, there is no information in the system, therefore the information is gathered from the carrier then the record for tracking and tracing is created. Therefore it is the examiner's position that Bilibin discloses this feature, as claimed.

39. With respect to Applicant's argument that Guidice is confined to only one supplier's website: Guidice is only used to show the linking of information between user identifiers and item status information, not the retrieving information from multiple sources. However it should be noted that the applicant claims from "one or more" sources, therefore prior art only receiving

information from one source is still considered to read on the claim. The applicant is not arguing Guidice as it was applied in the rejection.

40. With respect to Applicant's argument in terms of the Kanevsky reference: The applicant has stated that the invention is not drawn to a method of obtaining a piece of scanned mail in paper format or email format. Instead the applicant's system acquired information about packages sent to or from the user and creates linked information about the packages. It should be pointed out that the claims are directed towards mail pieces, not packages, therefore a letter is still within the realm of the invention. Furthermore, the applicant claims an attachment of the contents of the mail piece, therefore a scanned piece of mail which is sent as an email attachment would in fact be directed towards the claimed limitation.

41. The applicant's arguments are not considered to be persuasive; therefore the rejection stands as stated above.

Due to the 112 paragraph rejections which arose from the amended claims as well as some of the original portions of the claims, this action has not been made final, due to the new rejections which were not caused by the amendment..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629